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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91217941
Party	Plaintiff Robert Kirkman, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ROBERT KIRKMAN, LLC, Opposer, -against- PHILLIP THEODOROU and ANNA THEODOROU, Applicants.	**Opp. Nos. 91217941 (parent), 91217992, 91218267, 91218669**

OPPOSITION TO APPLICANTS' MOTION TO DISMISS

Pursuant to Trademark Rule of Practice 2.127, Opposer Robert Kirkman, LLC ("Opposer") hereby opposes Applicants Phillip Theodorou and Anna Theodorou's (collectively, "Applicants") motion (the "Motion") to dismiss the consolidated opposition proceeding (the "Opposition").

PRELIMINARY STATEMENT

Opposer, owner of the mark THE WALKING DEAD (the "WALKING DEAD Mark") in connection with a variety of goods and services, brought this consolidated Opposition proceeding against Applicants' applications Serial Nos. 86/166,802, 86/181,789, 86/183,334, 86/133,235, and 86/270,745 (collectively, the "Applications"), all for the mark THE WALKING DEAD ("Applicants' Mark"). In each of its Notices of Opposition (collectively, the "Notices of Opposition"), Opposer alleged that THE WALKING DEAD Mark was used and became famous in the United States long before Applicants filed their Applications for Applicants' Mark for similar or identical goods and that Applicants' Mark was likely to cause confusion with and/or to dilute THE WALKING DEAD Mark. In response to Opposer's Notices of Opposition, Applicants filed Answers *pro se* (collectively, the "Answers"), each one of which denies

Opposer's claims and avers that the registration of Applicants' Mark will not damage Opposer "nor impair distinctiveness of any products or services currently in the Market." (Opposition No. 91217941, Answer at 2.) Applicants did not assert any affirmative defenses in their Answers. (*See id.*)

Months after than the last of Applicants' Answers was filed and this Opposition was consolidated, Applicants filed the instant Motion, also *pro se*, styled as a "Motion to Dismiss Plaintiff's Opposition Due to Unclean Hands." Applicants' Motion is entirely without merit. *First*, Applicants' Motion, as set forth in the Motion itself, was not served on counsel for Opposer and therefore should be given no consideration. *Second*, Applicants' Motion improperly seeks to dismiss the Opposition based on an affirmative defense not pleaded in Applicants' Answers. *Third*, the Motion is based entirely on allegations unsupported by evidence and does not supply any proper grounds for dismissal of this Opposition proceeding.

Applicants' incorrect statements of fact and law in an unserved Motion are insufficient to overcome Opposer's well-pleaded allegations in support of its Opposition to the registration of Applicants' Mark. Applicants' Motion must be denied.

I. STATEMENT OF RELEVANT FACTS

As alleged in the Notices of Opposition, Opposer is the owner of all rights in and to THE WALKING DEAD Mark as used in connection with its series of comic books and graphic novels, and by Opposer's licensee AMC Network Entertainment LLC ("AMC"), in connection with *The Walking Dead* television series (the "Series"). (*See* Opposition No. 91217941, Not Opp. ¶ 1.) In addition, Opposer, through AMC, its corporate affiliates and sublicensees, has marketed an array of Series-related goods and services under THE WALKING DEAD Mark. (*Id.* ¶ 2.) As a result of Opposer's reputation, use, sales success and significant investment in advertising, THE WALKING DEAD Mark has developed secondary meaning and significance

in the minds of the public and has become a strong trademark identifying Opposer's products exclusively. (*Id.* ¶ 3.) Moreover, as a result of Opposer's reputation, use, sales success, popularity, and investment in advertising, THE WALKING DEAD Mark has become a famous trademark. (*Id.* ¶ 4.) Opposer also owns numerous U.S. trademark registrations for THE WALKING DEAD Mark in connection with various goods and services, including those relating to entertainment services and consumer products, including, but not limited to, U.S. Registration No. 4,443,715, U.S. Registration Nos. 4,007,681, U.S. Registration No. 4,429,084, and U.S. Registration No. 4,314,918. (*Id.* ¶ 5.)

In opposing Applicants' Applications, Opposer alleged, *inter alia*, that Applicants' Mark was identical to THE WALKING DEAD Mark and that Applicants' goods and services to be offered under Applicants' Mark were closely related to goods sold and services offered under the famous THE WALKING DEAD Mark. (Opposition No. 91217941, Not Opp. ¶¶ 11-12.) Opposer further alleged that use and registration of Applicants' Mark is likely to cause confusion with and to dilute THE WALKING DEAD Mark in violation of Sections 2(d), 13(a), and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052(d), 1063(a), 1125(c). (*Id.* ¶¶ 13-15.)

Applicants Answered the Notices of Opposition, denying Opposer's allegations and requesting that the Oppositions be dismissed with prejudice. (*See, e.g.*, Opposition No. 91217941, Answer.) Applicants did not assert any affirmative defenses in their Answers. (*See id.*)

Several months after the last Answer was filed, Applicants filed the instant Motion on March 16, 2015. As set forth in the certificate of service attached to the Motion, Applicants served the Motion on the same day on Elise Tenen-Aoki, counsel to Opposer in connection with matters unrelated to this proceeding. (*See* Mot. at 4.) Applicant did not serve their Motion on counsel of record in this consolidated Opposition proceeding. (*See id.*)

II. ARGUMENT

The Motion can be denied on three distinct grounds, as discussed below: it was not served, relies on arguments not pled, and further is without merit in any event.

A. Applicants' Motion Fails For Lack of Service On Opposer

The Federal Rules of Civil Procedure and the Trademark Trial and Appeal Board Manual of Procedure require service of all documents filed in *inter partes* proceedings on every other party to the proceeding. *See* Fed. R. Civ. P. 5; Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 113.01 ("Every document filed in an inter partes proceeding before the Board . . . must be served by the filing party upon every other party to the proceeding."). Failure to comply with this rule will result in the Board's refusal to consider the unserved document or motion. *See* TBMP § 502.02(a) ("Every motion filed with the Board must be served upon every other party to the proceeding, and proof of such service ordinarily must be made before the motion will be considered by the Board."). *See also Buchan v. Livingood*, Canc. No. 92043742, 2005 WL 2747604, at *1 n.3 (T.T.A.B. Oct. 19, 2005) (brief lacking proof of service on opposing party given no consideration.).

In this case, Applicants themselves certify that service was made on a third party rather than on counsel for Opposer. (*See* Mot. at 4.) Specifically, as set forth in the Motion, Applicants served their Motion an attorney other than counsel of record in this proceeding. (*Id.*) Accordingly, according to Applicants' own certified statement, Applicants have not complied with the service requirement of the Federal Rules and the Trademark Board Manual of Procedure. The Board should refuse to review Applicants' unserved Motion, and should deny the instant Motion without consideration.

B. Applicants' Motion to Dismiss Fails Because It Is Based On An Unpleaded Affirmative Defense

Parties may not rely on unpleaded grounds in seeking judgment from the Board. *See, e.g., Nanny Poppins, LLC v. Maldonado*, Opp. No. 91187157, 2013 WL 3188900, at *1 n.8 (T.T.A.B. May 16, 2013) ("[T]he Board will not enter judgment on an unpleaded claim."); *Ridge Vineyards, Inc. v. Allied Mgmt., Inc.*, Opp. No. 91117041, 2002 WL 1258277, at *2 (T.T.A.B. June 5, 2002) ("The Board will generally not grant judgment on an unpleaded issue. This alone would provide ample reason to deny opposer's motion.").

Here, Applicants did not state any affirmative defenses in their Answers, opting instead to simply deny Opposer's claims. Because Applicants did not properly plead their defense of unclean hands, this affirmative defense is not properly before the Board and cannot serve as a basis for judgment in this Opposition. *See, e.g., Fallamni v. Khan*, Canc. No. 92051344, 2011 WL 11535911, at *1 (T.T.A.B. July 27, 2011) (unpleaded claim is not properly before the Board and must be disregarded). Accordingly, Applicants' motion for judgment on the pleadings must be denied.

C. Applicants' Motion Fails in Any Event

A motion for judgment on the pleadings[1] under Federal Rule of Civil Procedure 12(c) may be granted only when the material facts are not in dispute and judgment on the merits can be

[1] While Applicants style their Motion as a motion to dismiss, a motion to dismiss must be filed "before, or concurrently with, the movant's answer." TBMP § 503.01; *see* Federal Rule of Civil Procedure 12(b); *William & Scott Co. v. Earl's Rests. Ltd.*, 30 U.S.P.Q.2d 1871, 1872 (T.T.A.B. 1994). Applicants' Motion, filed months after Applicants' Answers to the Notices of Opposition, does not meet this standard. However, because Applicants are proceeding *pro se*, Opposer has liberally construed their Motion as a motion for judgment on the pleadings under Federal Rule of Civil Procedure 12(c), which may be filed "after the pleadings are closed, but prior to the opening of the first testimony period." TBMP § 504.01. When a movant relies on alleged facts outside the pleadings on a motion made under Rule 12(c), as Applicants have here, the Board must either exclude those matters or treat the motion as one for summary judgment. *See* TBMP § 504.03; Fed. R. Civ. P. 12(d). In this situation, summary judgment would be

achieved by focusing on the pleadings. *Leeds Techs. Ltd. v. Topaz Commc'ns Ltd.*, 65 U.S.P.Q.2d 1303, 1305 (T.T.A.B. 2002); *see also Chatam Int'l Inc. v. Abita Brewing Co.*, 49 U.S.P.Q.2d 2021, 2022 (T.T.A.B. 1998). For purposes of the motion, all well-pleaded factual allegations of the nonmoving party are assumed to be true, and the inferences drawn therefrom are to be viewed in a light most favorable to the nonmoving party. *Leeds Techs.*, 65 U.S.P.Q. at 1305. Therefore, a motion for judgment on the pleadings will only be granted when the moving party establishes that no material issue of fact remains to be resolved and that it is entitled to judgment as a matter of law. *Id.*

As set forth above, Applicant's motion is based on arguments not present in its pleadings. But even if substantive allegations set forth in the Motion were found in Applicant's pleadings, the Motion should be denied. *First*, Applicants argue that Opposer has somehow acted in bad faith with respect to its Application Serial No. 86/145, 914 by filing an amendment to allege use, arguing that an applicant cannot transform an intent to use application into one based on use. Applicants' arguments in this regard reflect total confusion about trademark law, and so the argument fails as a matter of law. Pursuant to 15 U.S.C. §1051(c), "[a]t any time during examination of an application filed under subsection (b) of this section, an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a) of this section."

Second, Applicants argue that Opposer is "using unethical tactics in commerce" in connection with its use of the ® symbol on unspecified "goods bearing The Walking Dead

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inappropriate, as Opposer has not been given any opportunity to pursue discovery. Accordingly, the Board should exclude the alleged facts outside the record introduced by Applicants as part of their Motion. In any event, since these facts are simply alleged, and not substantiated whatsoever with evidence, Applicants could not meet their burden under Fed. R. Civ. P. 56.

mark," and that such alleged tactics amount to unclean hands requiring dismissal of the Opposition. (*See* Mot. at 3.) Again, even taking this unsupported and baseless claim on its face, this does not constitute sufficient grounds to dismiss the Opposition. A defendant asserting the defense of unclean hands must demonstrate not only that the plaintiff has engaged in inequitable conduct, but that "the conduct relates to the subject matter of its claims." *Fuddruckers, Inc. v. Doc's B.R. Others, Inc.*, 4 U.S.P.Q.2d 1026, 1034 (9th Cir. 1987). In other words, "misconduct in the abstract, unrelated to the claim in which it is asserted as a defense[,] does not constitute unclean hands." *VIP Foods, Inc. v. V.I.P. Food Prods.*, 200 U.S.P.Q. 105, 113 (T.T.A.B. 1978). Here, Opposer's alleged use or non-use of the ® symbol on unknown goods is entirely unrelated to the subject of this Opposition proceeding, which is Applicants' applications to register marks likely to cause confusion with Opposer's registered THE WALKING DEAD Mark. Accordingly, Applicants' allegation must be disregarded.

Finally, Applicants claim that Opposer has "attempt[ed] to enforce trademark rights beyond a reasonable interpretation of the scope of the rights granted to the Plaintiff," including by sending a demand letter to Applicants requesting that Applicants abandon their application for Applicants' Mark. (Mot. at 2, 3.) But Applicants' disagreement with the substance of Opposer's claim and the scope of Opposer's rights is not a grounds for dismissal. In its Notices of Opposition, as set forth above, Opposer alleged that THE WALKING DEAD Mark was used and became famous in the United States long before Applicants filed their Applications for identical marks for similar or identical goods and thus that Applicants' Mark is likely to cause confusion with and/or to dilute THE WALKING DEAD Mark – allegations which amply satisfy the notice pleading standards set forth in the Federal Rules of Civil Procedure and the Trademark Rules of Practice. Nothing more is required of Opposer at this stage, and to the extent the scope of Opposer's rights are at issue, these rights will be tested through this Opposition proceeding.

Contrary to Applicants' apparent goal of circumventing this entire proceeding, both parties must participate in discovery and submit evidence and argument in the normal course before the Board may resolve this Opposition on the merits.

III. CONCLUSION

For all the reasons stated above, Applicants' Motion should be denied in its entirety.

Dated: New York, New York
April 6, 2015

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: _____

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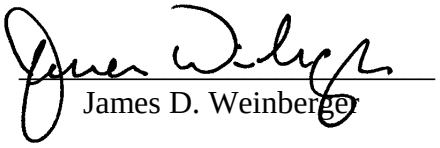
CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing was sent by first class mail postage pre-paid to Applicants' Correspondent of Record, this 6th day of April, 2015, to the following:

PHILLIP THEODOROU
446 EWINGVILLE RD
EWING, NEW JERSEY 08638-1539



James D. Weinberger